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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

WILLIAMS, MARK A

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/798,663 | WILLAT ET AL. | |
| | Examiner | Art Unit | |
| | Mark A. Williams | 3676 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-60 and 62-69 is/are rejected.
- 7) ☒ Claim(s) 61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tube being inserted between the first and second ends of the tubular member of claim 64, and the method step of claim 68, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 54, 55-59, 62, and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al., US Patent 4,911,569. Note especially the embodiments of figures 9-15. A writing instrument comprising an elongate body (2, 46, 1) having first and second ends; a writing mechanism 23 projecting from the body first end; and a deformable sleeve 35 having a generally tubular base 44 with a first diameter and defining an inner surface engaging the body near the writing mechanism, a generally tubular outer membrane 5 with a second diameter larger than the first diameter positioned generally concentric with the base, wherein respective ends of the base and outer membrane engage to define a cavity

there between, a sealable passageway 6 defined between adjacent ends of the tubular base and outer membrane in fluid communication with the cavity, and a formable material disposed in the cavity. The base and outer membrane are integrally formed from a single piece of material. The base and outer membrane are generally cylindrical. Opposite ends of the base and outer membrane engage one another to form flat edge portions on opposite ends of the sleeve. The base inner surface is sized to frictionally engage the body. Regarding claims 56-58, as shown in figure 12, the device appears to be formed as claimed, with a 180 degree fold.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. in view of David, US Patent 4,617,697. Although the embodiment of figures 9-11 do not explicitly teach the base and outer membrane being bonded together, Hashimoto does further teach the concept of attaching the

outer membrane to a similar base-like structure in an alternative embodiment (note figure 19). David provides teaching of a base 18 and outer membrane 16 being bonded together at 14, for the use in a handle environment. It would have been obvious at the time the invention was made for one skilled in the art to have included in the design of Hashimoto such a modification, as generally taught by David, for the purpose of providing an alternative arrangement that would have functioned equally as well.

5. Claims 64-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al in view of David and Tansill, US Patent 4,385,024. Although Hashimoto discloses the claimed structure, Hashimoto does not teach the claimed method of forming the device, being a method of forming a tubular sleeve on a writing instrument having an elongate body defining first and second ends and a writing mechanism projecting from the first end, the method comprising providing an elongate tubular member of flexible material having a first end, a second end, a larger diameter portion, and a smaller diameter portion; folding the smaller diameter portion back through the larger diameter portion so that the first end is adjacent the second end, thereby to form the tubular sleeve with a generally tubular base defining an inner surface and a generally tubular outer membrane concentric

with the base, a cavity being defined between the base and outer membrane; placing the generally tubular base over the body so that the inner surface engages the body near the writing mechanism, separating the first and second ends of the tubular member to define a passageway in fluid communication with the cavity, passing formable material through the passageway to fill the cavity; and sealing the first and second ends of the tubular member to close the passageway, as claimed.

David teaches a method forming a moldable handle adapter in which an elongate tubular member (see figure 1) of flexible material having a first end, a second end, a larger diameter portion 16, and a smaller diameter portion 18; folding the smaller diameter portion back through the larger diameter portion (see figures 7 and 8) so that the first end is adjacent the second end, thereby to form the tubular sleeve with a generally tubular base 18 defining an inner surface and a generally tubular outer membrane concentric with the base, a cavity 33 being defined between the base and outer membrane; placing the generally tubular base over a body 30 so that the inner surface engages the body.

Tansill teaches the concept of filling an article with a formable material via a tubular member through a passageway (see figures 6 and 10).

It would have been obvious at the time the invention was made for one skilled in the art to have formed the design of Hashimoto by the method disclosed

in the combination of David and Tansill, for the purpose of providing known means of forming the device in a simplified manner.

Regarding the first and second ends of the tubular member being sealed with adhesive or by heat, the examiner serves Official Notice that it is well known in the art of bonding to use such methods to seal element. It would have been obvious at the time the invention was made for one skilled in the art to have included in the design of the combination such a means of sealing, since both method would have providing sufficient sealing functioning, as known in the art.

Regarding an end of the tubular sleeve opposite the adjacent first and second ends of the tubular member is positioned below the first and second ends of the tubular member as the formable material is passed through the passageway, one skilled in the art would clearly understand to orient the device in such a manner in order to avoid spilling of the formable material.

Regarding squeezing the outer membrane to remove trapped air from the cavity prior to sealing, such a step is obvious since one would desire the cavity to be filled with only the formable material for a uniform fill.

Allowable Subject Matter

6. Claim 61 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to the claims of record have been considered but are moot in view of the new ground(s) of rejection. Newly discovered art has been applied as outlined in the above rejection.


Conclusion

This action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (571) 272-7064. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Williams
1/20/06 


BRIAN E. GLESSNER
SUPERVISORY PATENT EXAMINER